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MOTOROLA, INC			SAXENA, AKASH	
1303 EAST ALGONQUIN ROAD			ART UNIT	PAPER NUMBER
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SCHAUMBURG, IL 60196				
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		08/05/2008	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

APT099@motorola.com  
Docketing.Schaumburg@motorola.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,557	<b>Applicant(s)</b> RAPPAPORT ET AL.
	<b>Examiner</b> AKASH SAXENA	<b>Art Unit</b> 2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 May 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 and 32-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 and 32-77 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date 5/15/08
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claim(s) 1-17, 32-55 and 56-77 has/have been presented for examination based on amendment filed on 15<sup>th</sup> May 2008.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15<sup>th</sup> May 2008 has been entered.
3. Claim(s) 1, 11, 13-17 is/are amended.
4. Claim(s) 18-31 are cancelled.
5. Claim(s) 56-77 are new.
6. Claims 13—17 are rejected under 35 U.S.C. 101.
7. Claim(s) 1-17, 32-55 and 56-77 are newly rejected under 35 USC § 112 ¶1<sup>st</sup>.
8. Claim(s) 3, 13-17 are rejected under 35 USC § 112 ¶2<sup>nd</sup>.
9. Claim(s) 1-17, 32-55 and 56-77 are rejected under 35 U.S.C. 102(b) in view of SitePlanner User manual.
10. Claim(s) 1-17, 32-55 remain rejected under 35 USC § 103.
11. The arguments submitted by the applicant have been fully considered. Claims 1-17, 32-55 and 56-77 remain rejected and this action is made NON-FINAL. The examiner's response is as follows.

***Request for information under 37 CRF § 1.57***

37 CRF 1.57 (e) States:

**The examiner may require the applicant to supply a copy of the material incorporated by reference.** If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application.

12. In this case applicant has complied with requirement only in part by submitting sections of the non-patent literature which is completely incorporated in specification [0044]. Namely, applicant is requested to submit the complete document "SitePlanner 3.16 for Windows 95/98/NT User's Manual" (Wireless Valley Communications, Inc. 1999) or as presented in the IDS "SitePlanner 3.0 User's Manual" dated 1998.

***Response to Remarks for Claim Rejections - 35 USC § 101***

13. Examiner disagrees with the applicant that the amendment by the applicant overcomes the rejection. Please see updated rejection.

***Response to Remarks for Claim Rejections - 35 USC § 112 ¶1<sup>st</sup>***

14. Examiner withdraws the previous rejections to the claims under this statute in view of applicant's argument and evidence provided in IDS and specification. Please see new rejection in view of applicant's remarks and IDS.

***Response to Argument for Claim Rejections - 35 USC § 103***

15. Examiner has updated the grounds of rejection in view of applicant's arguments and amendment. Please see below.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 13-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 recites non-functional descriptive material as the computer executable instructions are not positively recited in the claim. Specifically, one or more applications which uses the site-specific computerized model provides at least one of performance models, cost determination, analysis, measurement, simulation, parts library etc., but does not perform them to compute the results of these processes. Hence the claim as a whole is deemed non-statutory.

17. Dependent claims do not seem to cure this deficiency and are rejected likewise.

***Claim Rejections - 35 USC § 112||1<sup>st</sup>***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claim 1-17, 32-55 and 56-77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter not properly described in the application as filed is described in specification

[0038] and [0044] through improper incorporation and is deemed to be essential subject matter by applicant in remarks Pg.16 & 17.

19. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

***Claim Rejections - 35 USC § 112<sup>12nd</sup>***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20. Claims 3, 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 13 (Updated 29/07/08)

Claim now recites, "said electronic file" which lacks antecedent basis.

Amended claim 13 discloses:

one or more software applications which use a site-specific computerized model of one or more physical environments, said one or more software applications providing at least one of:

Art Unit: 2128

MPEP 2106 states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

Other claims may also have similar problems with unclear language and examiner has merely stated above issues as exemplary deficiencies with the claim language.

Claims 14-17 do not cure the deficiency of claim 13 and are rejected for the same reasons as claim 13.

#### Regarding Claim 3

Examiner had rejected claim 3 as reciting the limitation "said information" having insufficient antecedent basis. Examiner withdraws this rejection in view of the amendment to the claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**21. Claims 1-17, 32-55 and 56-77 are rejected under 35 U.S.C. 102(b) as being**

**anticipated by "SitePlanner 3.16 for Windows 95/98/NT User's Manual"**

(Wireless Valley Communications, Inc. sic 1999) in view of applicant's own admission in specification [0038] and [0044].

© 1998 Wireless Valley Communications, Inc., Blacksburg, VA, USA. Wireless Valley® is a registered trademark. SitePlanner, InFielder, Predictor, and Optimistic are trademarks of Wireless Valley Communications, Inc. AutoCAD and Autodesk are registered trademarks of Autodesk, Inc. Windows, WindowsNT, Windows95, and Windows98 are registered trademarks of Microsoft, Inc. Pentium is a registered trademark of Intel Corp.

As an example the most comprehensive new claim is rejected by the SitePlanner above.

Regarding Claim 56

SitePlanner teaches a method for analyzing a communications network having a plurality of components (SitePlanner: Section 2.1 – showing components and base station communication parameters), the method comprising: obtaining a site-specific computerized model of a physical environment associated with the communications network (SitePlanner: Section 4); obtaining information pertaining to each of the plurality of components that are used in said communications network from a parts list library (SitePlanner: Fig.5.29), wherein at least some of said information includes frequency-dependent characteristics of particular ones of the plurality of components (SitePlanner: Fig.5.29 antennas are frequency dependent); modeling performance characteristics of the communications network based upon the information and the site-specific computerized model (SitePlanner: Pg.113, 116, 143, 144 ), wherein the modeling comprises evaluating the particular components based upon the frequency- dependent characteristics obtained from the parts list library (SitePlanner: Pg. 108 – performance of antennas); and displaying the performance characteristics on a computer display (SitePlanner: Pg.108).

Other independent and dependent claims are rejectable likewise.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**22. Claims 1-17 and 32-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over by IEE Article "WISE Design of Indoor Wireless Systems" by S.F. Fortune et al (Fortune hereafter), in view of article "Web Enabling Applications" by Brent Welch et al (Welch hereafter).**

Regarding Claim 1 (Updated 11/2/07)

**Fortune** teaches a software application (Fortune: Pg. 58 ¶2 "WISE") which provide or use a site-specific computerized model of one or more physical environments (Fortune: Pg.61 section "Acquiring database for buildings"), said software application executing at least two of (Fortune: See Pg. 60):

**Fortune** teaches step a) of modeling electrical performance of a communications network or one or more components which are or may be used in a communications network (Fortune: Pg. 67 Fig.7) and a parts list library forming part of software application comprising information pertaining to a plurality of components which are or may be used in said communications network and at least some of said information including frequency characteristics of particular components of said plurality of components and at least some of said plurality of components being wireless communication components (Fortune: Pg. 65 Section :"User Interface" showing plurality of base stations being placed into the site specific model; Fig.7 and associated text on Pg. 65 shows the modeling various parameters including frequency parameters for the network component – i.e. base station transmitter).

**Fortune** teaches step d) of providing analysis, measurement (*Fortune*: Pg.63 Optimization), or simulation (*Fortune*: Pg.66 Fig.5 and 6) of said communications network having said one or more components (*Fortune*: Pg. 67 Fig.7).

**Fortune** teaches that implementation language for the design comprises Tcl/Tk.

**Fortune** also teaches parts list which is displayed on the computer display (*Fortune*: Fig.7).

**Fortune** does not explicitly teach that pluralities of components are each represented by a standard mark up language in said parts list library.

**Welch** teaches converting Tcl/Tk into HTML (hypertext markup language) as embedded Tcklets (Pg.2) .

It would have been obvious to one (e.g. a designer) of ordinary skill in the art at the time the invention was made to apply the teachings of Hansen to Fortune to have the application web enabled and portable. The motivation to combine would have been that browser enabled application can be remotely executed besides the numerous advantages present with markup language (Hansen: Pg.1-2 Introduction).

#### Regarding Claim 2

Fortune does not teach using XML, mostly used to share data. Fortune in turn uses Tcl/Tk for the purpose of data sharing and graphical user interface (GUI) generation. Hansen teaches making Tcl/Tk GUI available in HTML, which like XML achieves the similar equivalent functionality and more without rewriting the code in browser usable language using XML.

Regarding Claim 3

Fortune teaches said information includes orientation data (Fortune: Pg. 61 Col.2 ¶3- Wall co-ordinate data), measured data (Fortune: Fig.1 measured signal strength), cost data (Fortune: Col.59 Col.1 Cost considerations).

Regarding Claim 4-6

Fortune teaches the interaction of two or more components from the parts list as strongest base transmitter determination, interaction between the receiver and transmitter (Fortune: Pg. 66 Col.1; Pg.60 Col.1 base station optimization – transmitter and receiver characteristics; electromechanical properties – Pg. 67 Fig 7 – antenna types).

Regarding Claim 7

Fortune teaches editing capability of the component parameters (Fortune: Fig.7).

Regarding Claim 8-9

Fortune teaches base station optimization being a component of the application (Fortune: Pg.67 Col.1 Last paragraph) and a separate application (Fortune Pg.60, Pg.64 Col.2 Last few lines).

Regarding Claim 10

Fortune does not teach library being accessible from remote location. Hansen teaches that remote accessibility of Tcl/Tk is one of the important reasons for the markup language and Tcl/Tk interface (Hansen: Pg. Introduction).

Regarding Claim 11

Fortune discloses a computer application being executed, where the model and programmable components are stored (Fortune: Pg. 61 Col.2 saving the model to raster file; Pg.65 saving the simulation results – “save power and rays”; Fig.7 saving the part information selection).

Regarding Claim 12

Fortune teaches parts library list having antenna radiation pattern (Fortune: Fig.7 – various types of antennas – hw-dipole, qw-dipole etc.).

Regarding Claim 13 (Updated 11/2/07)

Claim 13 discloses similar limitations as claim 1 and is rejected for the same reasons as claim 1. Fortune teaches a electronic file (Fortune: at least in Pg. 61 Section: “Acquiring databases for buildings”) having site specific computerized model of a physical environment and having computerized representation of one or more components obtained from the parts list (Fortune: Fig.5-7 and associated text).

Fortune also teaches step d) of providing analysis, measurement (Fortune: Pg.63 Optimization), or simulation (Fortune: Pg.66 Fig.5 and 6) of said communications network having said one or more components (Fortune: Pg. 67 Fig.7).

Regarding Claim 14

Claim 14 discloses similar limitations as claim 2 and is rejected for the same reasons as claim 2.

Regarding Claim 15

Claim 15 disclose similar limitations as claim 12 and are rejected for the same reasons as claim 12.

Regarding Claim 16

Fortune teaches said information includes orientation data (Fortune: Pg. 61 Col.2 ¶3- Wall co-ordinate data), measured data (Fortune: Fig.1 measured signal strength).

Regarding Claim 17

Claim 17 discloses similar limitations as claim 6 and is rejected for the same reasons as claim 6.

Regarding Claim 32 (Updated 11/2/07)

Fortune teaches a method for performing communications network analysis (Fortune: Pg.58¶2) using a site-specific computerized model of one or more physical environments (Fortune: Pg.61 section "Acquiring database for buildings") said software application performing one or more of a) modeling electrical performance of a communications network or one or more components which are or may be used in a communications network (Fortune: Pg. 67 Fig.7) and a parts list library forming part of software application comprising information pertaining to a plurality of components which are or may be used in said communications network and at least some of said information including frequency characteristics of particular components of said plurality of components and at least some of said plurality of components being wireless communication components (Fortune: Pg. 65 Section

: "User Interface" showing plurality of base stations being placed into the site specific model; Fig.7 and associated text on Pg. 65 shows the modeling various parameters including frequency parameters for the network component – i.e. base station transmitter).

Fortune teaches that implementation language for the design comprises Tcl/Tk.

**Fortune** also teaches step d) of providing analysis, measurement (**Fortune**: Pg.63 Optimization), or simulation (**Fortune**: Pg.66 Fig.5 and 6) of said communications network having said one or more components (**Fortune**: Pg. 67 Fig.7).

**Fortune** does not explicitly teach plurality of components are each represented by a standard mark up language in said parts list library.

**Hansen** teaches converting Tcl/Tk into HTML (hypertext markup language). It would have been obvious to one (e.g. a designer) of ordinary skill in the art at the time the invention was made to apply the teachings of **Hansen** to **Fortune** to have the application web enabled and portable. The motivation to combine would have been that browser enabled application can be remotely executed besides the numerous advantages present with markup language (**Hansen**: Pg.1-2 Introduction).

#### Regarding Claim 33

Claim 33 discloses similar limitations as claim 2 and is rejected for the same reasons as claim 2.

Regarding Claim 34

Claim 34 discloses similar limitations as claim 16 and is rejected for the same reasons as claim 16.

Regarding Claim 35

Claim 35 discloses similar limitations as claim 6 and is rejected for the same reasons as claim 6.

Regarding Claim 36-37

Claims 36-37 disclose similar limitations as claims 5-6 and are rejected for the same reasons as claim 5-6.

Regarding Claim 38

Claim 38 discloses similar limitations as claim 7 and is rejected for the same reasons as claim 7.

Regarding Claim 39

Claim 39 discloses similar limitations as claim 9 and is rejected for the same reasons as claim 9.

Regarding Claim 40

Claim 40 discloses similar limitations as claim 10 and is rejected for the same reasons as claim 10.

Regarding Claim 41

Claim 41 discloses similar limitations as claim 11 and is rejected for the same reasons as claim 11.

Regarding Claim 42

Claim 42 discloses similar limitations as claim 12 and is rejected for the same reasons as claim 12.

Regarding Claim 43

Claim 43 discloses similar limitations as claim 1 and is rejected for the same reasons as claim 1.

Regarding Claim 44

Claim 44 discloses similar limitations as claim 2 and is rejected for the same reasons as claim 2.

Regarding Claim 46

Fortune shows the model information being saved in the electronic file and the files being transferable between computers is well known in the art.

Regarding Claim 47

Claim 47 discloses similar limitations as claim 11 and is rejected for the same reasons as claim 11.

Regarding Claim 48

Fortune shows the model information being saved in the electronic file and the files being transferable between computers is well known in the art.

Regarding Claim 49 (Updated 11/2/07)

Claim 49 discloses similar limitations as claim 32 and is rejected for the same reasons as claim 32.

Regarding Claim 50

Claim 50 discloses similar limitations as claim 10 and is rejected for the same reasons as claim 10.

Regarding Claim 51

Claim 51 discloses similar limitations as claim 2 and is rejected for the same reasons as claim 2.

Regarding Claim 52

Claim 52 discloses similar limitations as claim 16 and is rejected for the same reasons as claim 16.

Regarding Claim 53

Claim 53 discloses similar limitations as claim 6 and is rejected for the same reasons as claim 6.

Regarding Claim 54

Claim 54 discloses similar limitations as claim 12 and is rejected for the same reasons as claim 12.

Regarding Claim 55

Claim 55 discloses similar limitations as claim 32 and is rejected for the same reasons as claim 32.

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AKASH SAXENA whose telephone number is (571)272-8351. The examiner can normally be reached on 9:30 - 6:00 PM M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini S. Shah can be reached on (571)272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Akash Saxena/  
Examiner, Art Unit 2128

/Alexander J Kosowski/  
Primary Examiner, Art Unit 2128